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REMARKS

The Examiner's comments together with the cited references have been carefully studied. Favorable reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

Claims 1-30 have been rejected. Claims 3, 5, 10, 16 and 23 have been canceled. Claims 1, 2, 4, 8, 9, 11, 12, 14, 17, 21 and 26 herewith are amended. Support for these amendments are in the original claims. Claims presently active are claims 1, 2, 4, 6 to 9, 11 to 15, 17 to 22, and 24 to 30. Favorable reconsideration of the application in view of the following remarks is respectfully requested

Claims 8 and 26 were rejected under 35 U.S.C. §112, second paragraph.

Applicants have made necessary amendments to the claims in accordance with the Examiner's comments in the Office Action. These amendments are believed to conform the claims to the requirements of the rules.

Claims 1-12 and 14-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over EP 0308750 in view of C. Hansch and A. J. Leo, in "Substituent Constants for Correlation Analysis in Chemistry and Biology." It is the conclusion of the Examiner that EP'750 discloses a composition comprising a base precursor that is a salt of an organic base with an arylsulfonylacetic in association with a compound, which is useful in photography, and which is heat developable substantially as claimed. The Examiner states that Leo discloses substituent constants for correlation analysis in chemistry and biology. The Examiner alleges it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to substitute a known equivalent substituent (for a monovalent substituent known in the art) such as disclosed by Leo in the base precursor compound taught in EP'750 with a reasonable expectation of success.

This rejection is respectfully traversed. The Examiner concedes that the difference between EP'750 and that of the presently claimed invention is the substituent $(C=O)-O-R^1$ associated with the phenyl ring. In fact, EP '750 lists halogen, alkyl, alkylsulfonyl, arylsulfonyl, acylamino and sulfamoyl as possible substituents, and not the substituent required in the

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present invention. This is further underscored by the fact that EP'750 discloses numerous compounds (Compounds A-1 to A-21 and Compounds 1 to 40) all of which fall outside the scope of the present invention.

Furthermore, the present compounds with the $-(C=O)-O-R^1$ substituent, used in Applicants' invention, were shown not equivalent to the prior art compounds. Specifically, the comparison compound used in the present application CB-1 on page 55 was found, in copending application USSN 10/765,340, to be better than one of the compounds disclosed in EP'750, namely Compound 7 on page 13 of EP'750. The presently claimed base precursor was shown to exhibit improved sensitometric characteristics as well as the absence of pin holes, a problem with the best comparison. Leo does not show the equivalence of substituents. In fact, Leo shows that $SO_2C_2H_5$ is a lot more electron-withdrawing than CO_2CH_3 , for example σ_p for the former is 0.72 while it is 0.45 for the latter, a factor of over 1.5. Moreover, Leo says nothing with respect to the effect of changing substituents on the bleaching of a filter dye.

In view thereof, it follows that the subject matter of the claims would not have been obvious of EP'750 in view of C. Hansch and A. J. Leo at the time the invention was made.

Claims 3, 11, and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over EP 0308750 in view of C. Hansch and A. J. Leo, in "Substituent Constants for Correlation Analysis in Chemistry and Biology" and further in view of Helland et al. It is the conclusion of the Examiner that "It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to produce a thermal bleachable dye using a filter dye in association with the an arylsulfonyl acetic acid obtained by the combination EP'750 and Leo with an reasonable expectation of success, and thereby provide an invention as claimed."

The rejection is traversed for the reasons stated with respect to claim 1 above.

In view thereof, it follows that the subject matter of the claims would not have been obvious of EP'750 in view of C. Hansch and A. J. Leo, and further in view of Helland et al. at the time the invention was made.

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Claims 1 and 9 have been rejected under 35 U.S.C. §103(a) as being unpatentable Hirai et al. The Examiner states that The STIC Search Report discloses an arylsulfonyl acetic acid on page 8, disclosed by Hirai et al., which contains two (C=O)-OMe groups, compared to the present invention, which contains a single such group. It is the conclusion of the Examiner that "It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use one or more similar groups with a reasonable expectation of success."

The rejection is traversed for the reasons stated with respect to claim 1 above. In addition, the presence of two (C=O)-OMe groups will obviously have twice the effect on the phenyl ring as a single (C=O)-OMe group, there being no expectation or predictability that twice the effect of a substituent group would have the same effect on the compound as a whole when it is used as a base precursor. Furthermore Hirai et al. use a very different organic base than that required by the present invention. One of ordinary skill in the art could not predict the effect of using a substantially different organic base with a substantially different base precursor.

In view thereof, it follows that the subject matter of the claims would not have been obvious further in view of Hirai et al. at the time the invention was made.

Applicants have reviewed the prior art made of record and believe that singly or in any suitable combination, they do not render Applicants' claimed invention unpatentable.

In view of the foregoing remarks and amendment, the claims are now believed allowable and such favorable action is courteously solicited.

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Should the Examiner consider that additional amendments are necessary to place the application in condition for allowance, the favor is requested of a telephone call to the undersigned counsel for the purpose of discussing such amendments.

Respectfully submitted,



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